



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In Re Appln. of: Robert Filepp et al.

Group Art Unit: 2307

JUL 24 1996

Serial No.: 08/158,029

DIRECTOR'S OFFICE
GROUP 2300

Examiner: Wayne Amsbury

Filed: November 26, 1993

Title: METHOD FOR LOCATING APPLICATION RECORDS
IN AN INTERACTIVE-SERVICE DATABASE

*Treated as a request for reconsideration,
as per paper # 19*

PETITION UNDER 37 CFR §181 TO
COMPEL ENTRY OF
AN AMENDMENT SUBMITTED UNDER 37 CFR §1.116

Commissioner of Patents and Trademarks
Washington, D.C. 20231

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Sir:

GROUP 2300

Applicants hereby petition the Commissioner of Patents and Trademarks under 37 CFR §1.181(a) to direct the Examiner in the above-captioned matter to enter the **Amendment After Final Rejection Under 37 CFR §1.116** which Applicants have submitted, and which the Examiner has arbitrarily and capriciously refused to enter.

I. THE FACTS

By action dated January 19, 1995, the Examiner in the above-captioned matter finally rejected Applicants' pending claims as amended on various grounds under 35 U.S.C. §112, second paragraph, and under 35 U.S.C. §102(b) in view of U.S. patent 4,429,385, Cichelli et al. Applicant, by notice dated July 19, 1995, initiated an appeal of the Examiner's final rejection to the Patent and Trademark Board Of Patent Appeals and Interferences. In connection with that appeal, Applicants prepared an amendment

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under 37 CFR §116 in order to put the rejected claims in better form for appeal, and submitted the Amendment together with Applicants' Appeal Brief to the Patent and Trademark Office on January 19, 1996.

By Action dated February 28, 1996, the Examiner advised Applicants that he would not enter the Amendment because, in the Examiner's asserted opinion, the Amendment would allegedly raise new issues that would require further consideration and/or search, the Examiner further contending only that the scope of claims 6-11 would be change by the proposed amendment.

On March 22, 1996, Applicants' attorney contacted the Examiner by telephone to seek an explanation of the Examiner action and to request reconsideration. In that telephone conversation the Examiner stated he would grant Applicants' Attorney the requested telephonic interview provided, Applicants' attorney prepared and forwarded by FAX to the Examiner a proposed agenda for the interview.

However, when Applicants' attorney subsequently prepared the required agenda and forward it to the Examiner by FAX, the Examiner, thereafter, refused to further discuss the matter when Applicants' attorney telephoned the Examiner to undertake the interview as previously agreed.

II. Nature of the Amendment

The Examiner's refusal to enter Applicants' Amendment is improper. The Amendment proposed by Applicants' is directed only to matters of form and does not materially affect the scope of the claims. The Amendment was solely and completely directed to putting the claims in better form for appeal. Under the clear wording of Rule 116, the Examiner should have entered the Amendment. And, his refusal to do

so can only be viewed as an attempt to avoid the adverse effect entry of the amendment would have on the Examiner's position in the Appeal.

In the amendment submitted, Applicant proposed to simply amendment four claims, specifically pending Claims 6, 11, 13 and 15. Applicants' proposed claim amendments merely sought to correct typographical errors and provide editorial simplification. Specifically, in Claim 6, Applicants proposed to change the claim wording to note that the records to be searched in accord with Applicants' method were objects used in generating interactive applications.

Specifically, Applicants proposed Claim 6 be amended as follows:

6. (Twice Amended) The method of claim 5 wherein the records to be searched for and retrieved are objects used in generating interactive applications associated with an interactive service[, and wherein the applications are arranged to be generated from objects].

As is plain from the proposed amendment, no change in scope or meaning of the claim was intended or sought, and no new issues or need for search were presented.

As a second amendment, Applicants proposed to change Claim 11 by adding an "s" to the word "system" in the preamble to correct a typographical omission and provide correct number agreement. Additionally, Applicants proposed to eliminate a "J" improperly entered in part "f" of the claim when it was first amended and add the word "and" at the end of part d to provide a transition between parts "d" and "e."

Specifically, Applicants proposed the following:

11. (Twice Amended) A method of searching for and retrieving applications included as records in an interactive service database stored in a computer network, the network having a plurality of reception systems at which respective users can request and retrieve applications, and the applications being made up of objects collectively containing presentation data and program instructions, the method comprising the steps of:

a. preparing a plurality of tables, each table including keywords respectively referenced to application identifiers so that each establishes a predetermined subset search of the applications stored in the service database;

- b. providing each table with a unique code designation;
c. generating a table code designation in response to a query entered at the reception system for an application;
d. comparing the table code designation generated with the available table code designation to select a table suited to the query; and
e. providing the table at the reception system at which the query was entered so that the requested application may be identified from the table and so that the application may be retrieved at the reception system where the query was entered[]; and
f. processing the table identified applications at the reception system where the query was entered[]].

As is again plain, no change in claim scope was intended or sought, and no new issues or need for search were presented.

Still further, Applicants proposed to amend Claim 13 to correct yet other typographical errors. Specifically, Applicants proposed to change the word "identifiers" following the words "table code" to the word "designations" to conform description of the table codes to the description in the claims from which Claim 13 depends. Additionally, Applicants proposed to change the word "applications" to "an application" to provide proper number agreement, and addition of the word "each" to more clearly describe the table code designations.

Specifically, Applicants proposed Claim 13 be amended as follows:

13. (Twice Amended) The method of claim 12 wherein generating the table code [identifiers] designations includes receiving a query for [applications] an application produced using one of a plurality of different procedures and translating the query produced using one of the different procedures into a single procedure common to all procedures for generating the table code designations, the table code designations each including one or more letters in combination to uniquely identify a table.

Here again, it is obvious the sole intention was to correct typographical errors and provide grammatical correctness. No new issues were presented and no need for additional searching arose.

Finally, Applicants proposed to amend Claim 15 to simplify claim wording and to remove the Examiner's antecedent objection to the terms "text and graphic data."

Specifically, the Applicants proposed that Claim 15 be amended to read as follows:

15. (Twice Amended) The method of claim 14 wherein the processing of table identified applications includes collecting at the reception system the objects which make up [the] an application [that are] derived by using [the] an identified table, and executing the objects so as to present the [corresponding text and graphic data for review] the application at the reception system.

Once again, no change to claim scope was intended or sought, and no new issues or need for new searching was presented.

III. The Examiner's Response to the Proposed Amendment

As noted, the Examiner's response to the proposed amendment, was to refuse its entry. Without any explanation, the Examiner simply asserted that "[t]he scope of claims 6-11 is changed by the amendment."

The Examiner's contention is plainly without foundation both as a matter of fact and as a matter of law. He has neither made any factual showing to demonstrate a change in claims scope nor offered any analysis which would support an interpretation of the claims as amended having a meaning substantially different from the meaning of the claims before amendment. By the clear wording of the proposed amendments, the scope of the claims proposed to be amended was not changed. Rather, the intended purpose and plain effect of the amendments were to provide changes to form only. And, by the express wording of 37 CFR 1.116, Applicants should be permitted to amend their claims to put them in better form for appeal. That was all that Applicants' proposed amendment did. The changes were addressed solely to correction of typographical errors and the providing of editorial simplification.

The Examiner's refusal to enter the amendments is arbitrary and an abuse of discretion.

Applicants request that the Examiner be compelled to enter the amendment as filed.

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In the event the Commission has question concerning this matter, Applicants ask that they be contacted so that any required information or assistance in resolving this matter may be provided.

Submitted herewith is an attorney's check in the amount of One Hundred and Thirty (\$130) Dollars to cover the fee for the petition. Calculation of the fee has been based on 37 CFR §1.17(h).

Dated: April 29, 1996

Respectfully submitted,

By: 

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope address to the Commissioner of Patents and Trademarks, Washington, D.C., 20231 on January 19, 1996.

Name of Registered Representative: Paul C. Scifo, Esq.

Signature: 

Date: April 29, 1996

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